

having memory, said [coiled toy] wire comprising:

i) a [coiled section] helical section, said [coiled section] helical section ranging in length from about two and three-quarter inches to about six inches. and

ii) a handle [section], said handle [section] being integral with said [coiled section] helical section, said handle [section] comprising a straight section of said wire extending outwardly from [the coiled section] said helical section [in the form of a straight piece.] wherein said handle ranges in length from about 3 ½ inches to about 6 ½ inches.

### REMARKS

Applicant notes that the Office Action of September 17, 2002 is a Final Action. Applicant states that the Office Action cites “new art” not previously presented in the prior Office Action. While the claims were amended, the amendments were principally a combining of the independent and some dependent claims. The basic invention taught in the claims is the same and no new issues were raised.

MPEP 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).**

The Office Action also states that claims 22-24 are inally rejected under 35 U.S.C. 103(a) as being unpatentable over Starr, and notes that Starr teaches in figures 1-6 most of the elements of the claimed invention, including a single unitary piece of material having memory (24) , a coiled section (fig. 5), and a handle section (22). While the Office Action states that Star fails to teach a handle section having a length between a range of 3 ½ inches to 6 ½ inches. the Office Action states that Starr teaches a hanlde section 22 that secures the spring thereto, and that it would have been obvious to use a handle section having a length between a range of about 3 ½ to 6 ½ inches.

Applicants respectfully disagrees. Claim 22 states:

-22) A flexible, retractable coiled toy comprising:

a single, unitary wire having a circular cross section and having memory, said wire comprising:

i) a helical section, said helical section ranging in length from about two and three-quarter inches to about six inches. and

ii) a handle, said handle being integral with said helical section, said handle comprising a straight section of said wire extending outwardly from said helical section wherein said handle ranges in length from about 3 ½ inches to about 6 ½ inches.

Starr does not teach a single unitary piece of material, nor does it teach the same handle as taught by a handle section described in the invention. The invention of the patent application teaches a handle section **integral with the coiled section, the handle section comprising a straight section of said coil.** Starr does not teach a handle section integral with the coiled section, nor does it teach a straight section forming the handle extending integrally from the material used for the coil.

In contrast, Starr discloses a paddle ball having a wooden handle. The paddle ball taught by Starr comprises three parts (a spring, a ball, and a paddle), as opposed to the invention of the peent invention. The handle referred to in 22 of the patent is the wooden paddle. The coil spring 24 does not have a handle. There is no straight section of the coil material to form a handle.

Starr's patent does not allow for its use as a lasso to capture items, as a clothing ornament, as a toy to manipulate, etc. Starr's patent is simply for a paddle ball toy.

In ascertaining the differences between the prior art and the claims at issue (the second factual inquiry of *Graham v. John Deere*), it is essential to view the claims at issue as "the invention as a whole," as required by 103 and "without the benefit of hindsight vision afforded by the claimed invention." *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n. 5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986). Similarly, it is essential to consider all elements of the claimed invention; it is impermissible to compare the prior art with what the viewer interprets the "gist" of the invention to be. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir. 1984). In *Jones v. Hardy*, 727 F.2d 1524, 1527-28, 220 USPQ 1021, 1024 Fed. Cir. 1984), the court held that reducing a claimed invention to an 'idea' and then determining patentability of the 'idea' is error.

The Office Action of the present invention is in fact using hindsight to see the present invention from the prior art. None of the prior art suggests a flexible, retractable coiled toy, comprising

a single, unitary piece of material, said material having memory and having a circular cross section, said coiled toy comprising:

a coiled section, said coiled section ranging in length from about two and three-quarter inches to about six inches and a handle section, said handle section being integral with said coiled

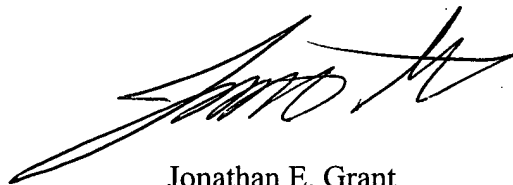
section.

The Office Action also states that Claim 25 is rejected under 35 U.S.C 103 as being unpatentable over star in view of Bidwell, and that Claims 26 and 27 are rejected as being unpatentable over Starr in view of Molenaar.

As independent claim 22 is now allowable, the dependent claims are allowable. It should be noted that the coiled materials in Bidwell and Molenaar are flat, and not circular in nature.

The application is now in condition for allowance. Please call or fax me at (301) 603-9071 if you have any questions or comments.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jonathan E. Grant', with a stylized, flowing script.

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